

Docket No. WCO1520-2

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellant : Petras et al.
Serial No. : 10/624,345
Technology Center : 2100
Art Unit : 2166
Filed : 7/22/2003
Title : SYSTEM FOR CREATING AND MAINTAINING A DATABASE
OF INFORMATION UTILIZING USER OPINIONS
Examiner : Shew Fen Lin
Docket No. : WCO1520-2

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANT'S REPLY BRIEF

Dear Sir,

In response to the Examiner's Answer mailed 9/17/2008, appellant submits the following
Reply Brief for consideration by the Board.

Appellant maintains all of appellant's previous arguments and includes all such arguments
herein by this reference.

CERTIFICATE OF TRANSMISSION

I hereby certify that, on the date shown below, this correspondence is being transmitted to the U.S. Patent and Trademark
Office by EFS-Web.

Date: November 17, 2008

/Michael D. Volk Jr./
Signature
Michael D. Volk Jr.
(type or print name of person certifying)

ISSUE 1: 35 USC §112

With regard to the word “substantially”, the Examiner argues that the rejection should stand since 1) the claim itself does not provide a definition of “website management system”, and 2) the word “substantially” is indefinite since, when given its broadest reasonable interpretation, one of ordinary skill in the art would interpret the word “substantially” as having more than one interpretation.

With respect to 1) above, the Examiner’s comment is not on point. The issue on appeal is whether the presence of the term “substantially” is definite or not. The issue is not, as the Examiner asserts, whether the phrase “website management system” is defined within appellant’s claim. Appellant has shown that the term “substantially” is definite and clear in this case.

With respect to 2) above, the Examiner apparently asserts that any word that has more than one reasonable interpretation is indefinite. The Examiner has simply not demonstrated through specific examples that one of ordinary skill in the art would interpret the term substantially in more than one reasonable way. Appellant has demonstrated that the phrases “substantially automatic website management system” and “substantially-automatic website managing” refer to a website that does not require ongoing management. One would not reasonably interpret this language as requiring, for example, the opposite meaning, *i.e.*, constant ongoing management. Again, the Examiner has not provided examples as to any other interpretations of the word “substantially” in appellant’s claims. Appellant respectfully submits that its claim language is definite and seeks reversal of the examiner.

With respect to Claims 52 and 70, the Examiner argues that since appellant’s claim language recites the term “if any” the claim scope is unascertainable since the metes and bounds of the claims are allegedly unclear. Actually, it appears to appellant that the Examiner understands the claim language. Thus there is no dispute other than a formal rejection. Appellant respectfully adds

that the scope of a claim is not indefinite merely because a condition is set forth for performing it. Furthermore, it is respectfully submitted that a patentee is not required to set forth alternate steps to perform when a condition is not met. Appellant respectfully submits that its claim language is definite and seeks reversal of the examiner.

ISSUE 2: 35 USC §102, HAMLIN

The Examiner's first point is that Hamlin discloses a set of subjects to be evaluated. Appellant respectfully submits that Hamlin simply uses a conventional survey. Appellant's claimed invention is different. To illustrate appellant's claimed invention, the following example is provided. In one such example, the "subject" of the survey is an "exceptional experience" such as "a succulent steak, a cozy campsite, neighborhood sports bar". **The user then chooses a list of pre-selected descriptive words (e.g., "tasty, romantic, friendly service") associated with the subject. The user then rates the importance of each of these words giving each of them a numerical value (e.g., 5 for "extremely", "4" for "very", etc.).** This novel type of survey is not disclosed, taught or suggested by the Hamlin reference.

The Examiner's second point relating to Hamlin is that appellant's claim recites the word "subject", but that appellant is arguing about the word "survey". Appellant respectfully submits that Claim 35 clearly states, "a such set of natural-language terms to be rated as to relevancy to each **subject**", not "survey". Further, appellant's argument clearly rates the relevancy of a natural language term with respect to the subject, not the survey.

The Examiner's third point relating to Hamlin is that Hamlin discloses providing appropriate responses relevant to the selected question type. For example, in Hamlin, when asked a question, the user may choose among "strongly agree", "agree", etc. Appellant's claimed invention is different in that the user determines the relevancy of the word. For example, in appellant's claimed invention if

the user thinks that the word “agree” is not relevant to the subject, the user would rate the term as a “1”. Put another way, the Hamlin system is not designed to do what appellant’s claimed invention does. In Hamlin, the user does not determine whether each of the terms “strongly agree”, “agree”, “neither agree nor disagree”, “disagree” or “strongly disagree” are each relevant to the subject by selecting among, for example, five relevancy indicators (for example, 5 – extremely relevant, 4 – very relevant, 3 – somewhat relevant, 2 – slightly relevant, 1 – not at all relevant) for each of the terms “strongly agree”, “agree”, “neither agree nor disagree”, “disagree” or “strongly disagree”.

The Examiner also argues that Hamlin does disclose the subject matter of Claim 36. Appellant respectfully submits, in addition to the arguments set forth in the appeal brief, that each and every limitation of the claim, as they arranged in the claim, must be considered in determining whether a reference anticipates the claimed invention.

The advantages of appellant’s claimed invention over the Hamlin reference should appear clear. For example, appellant’s system provides a richer description of subjects to be maintained in a structured way. A user may then search for an “experience” (e.g., a succulent steak, a cozy campsite, a romantic getaway, etc.) instead of sifting through paragraphs upon paragraphs of user comments. Further, and as another example, appellant’s claimed invention provides measurable data based on how many users rated the word “romantic” as “extremely relevant” regarding a particular subject (“a romantic getaway”). Since determination of what is “romantic” or what is “great food” is arguably a cultural phenomenon, appellant’s claimed invention seeks to measure that “approval” rating of what is “romantic” or “great” in a multicultural society. The result, in a shopping experience, for example, is more informed consumers.

Reversal of the rejection of the claims under 35 USC §102 is respectfully sought.

ISSUE 3: 35 USC §102, HILL

With respect to Hill, the Examiner asserts that Hill stores “evaluation information” in a database. The evidence supplied by the Examiner is a sentence from Hamlin that states that “comments by a user” are stored in a database. As stated above, this is not appellant’s claimed invention. Appellant’s claimed invention provides structure to rate the relevancy-degree of natural language words related to a particular subject. Appellant’s claimed invention is not, as the Examiner suggests, storing paragraphs and paragraphs of user comments in a database.

The Examiner’s second point relating to Hill is, essentially, that Hill discloses that the user comments in the database are searchable. Appellant notes that when a user searches user comments, the user may see that a user praised the resources of a particular park by glancing and reading the paragraphs of user comments. However, appellant respectfully submits that this is not appellant’s claimed invention. To illustrate the distinction, appellant provides the following example. With respect to particular resources of a forest park (a subject), an embodiment of appellant’s claimed invention may provide a survey to a user with the terms “friendly staff”, “well groomed trails”, etc. The system then solicits relevancy-degree ratings (e.g., 5 – extremely relevant, 4 – very relevant, 3 – somewhat relevant, 2 – slightly relevant, 1 – not at all relevant) for each natural language term (e.g., “friendly staff”). Appellant’s system then provides the clear advantage that a user will not have scour potentially rambling text provided by a user to extract the vital information for which the user is searching. If the user is searching for “well-groomed trails”, the parks in which other users have found the term “well-groomed trails” to be highly relevant would preferably be presented to the user. Appellant once again stresses that this system is different than a plain listing of user comments which is disclosed in Hill.

The Examiner further asserts that Hill discloses different newsgroups related to particular areas. Appellant respectfully submits that the point the Examiner is trying to make is unclear to

appellant. Appellant's Claims 48 and 49 set forth the feature of searchably capturing for such database such knowledge of users concerning useful knowledge sources outside such group of users.

Reversal of the rejection of the claims under 35 USC §102 is respectfully sought.

ISSUES 4, 5, and 6: 35 USC §103

With respect to the §103 rejections, the Examiner asserts that the rejections are based on the arguments of the §102 rejections. Appellant respectfully submits that since appellant has shown that the §102 rejections are not anticipating references, the §103 rejections should be held allowable.

Reversal of the rejection of the claims under 35 USC §103 is respectfully sought.

ISSUE 7: OTHER RATIONALE

With respect to Issue 7, the Examiner essentially argues that the "3-prong" test of MPEP §2181 has not been met. Appellant respectfully disagrees. Claims 64-85 meet the three prong test of MPEP §2181. The claim limitations use the phrase "means for", the "means for" is modified by functional language; and the phrase "means for" or "step for" is modified by sufficient structure, material, or acts for achieving the specified function. It is respectfully submitted that Claims 64-85 have not been properly examined, and the rejection of these claims must be withdrawn. Reversal of the rejection of Claims 64-85 is respectfully sought.

CONCLUSION

The Appellants have demonstrated that the present invention as claimed is clearly presented in proper form and distinguishable over the prior art of record. Therefore, the Appellants respectfully request the Board of Patent Appeals and Interferences to reverse the final rejection of the Examiner and instruct the Examiner to issue a notice of allowance of all claims.

If there are any fees necessitated by the foregoing communication, please charge such fees to, or credit any overpayment, to our Deposit Account No. 50-1887.

Respectfully submitted,

Date: November 17, 2008

/Michael D. Volk Jr./

Michael D. Volk Jr. (Reg. No. 59,338)
STONEMAN VOLK PATENT GROUP
3770 North 7th Street, Suite 100
Phoenix, AZ 85014 US
Tel: 602.263.9200 | Fax: 602.277.4883
michael@patentdoc.com